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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,047	07/10/2001	Paul Irma Albertus Van Dijk	CM2394M	7758

27752 7590 06/23/2003

THE PROCTER & GAMBLE COMPANY
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EXAMINER	
OH, SIMON J	

ART UNIT	PAPER NUMBER
1615	7

DATE MAILED: 06/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Application No.	Applicant(s)	
	09/902,047	VAN DIJK, PAUL IRMA ALBERTUS	
	Examiner	Art Unit	
	Simon J. Oh	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 April 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Papers Received

Receipt is acknowledged of the applicant's amendment, response, and petition for extension of time, all received on 01 April 2003. Receipt is acknowledged of the applicant's foreign priority document, European Patent Application 00870158.3, received on 07 April 2003.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of Claim 1 under 35 U.S.C. 112, fourth paragraph was made in error. The rejection of Claim 9 under 35 U.S.C. 112 is hereby withdrawn.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of Claims 1-7 under 35 U.S.C. 103(a) as being unpatentable over Van Dijk in view of Sanders is rendered moot with the cancellation of those claims.

The rejection of Claims 8-11 under 35 U.S.C. 103(a) is maintained.

Claims 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Dijk in view of Sanders.

The Van Dijk document teaches a coated detergent tablet composition, the coating comprising a dicarboxylic acid (See Abstract). Preferred dicarboxylic acids are those with 2 to 13 carbon atoms, and specifically listed acids include oxalic acid, malonic acid, succinic acid, glutaric acid, adipic acid (i.e. 1, 6-hexanedioic acid), pimelic acid, suberic acid, azelaic acid, sebacic acid, undecanedioic acid, dodecanedioic acid, tridecanedioic acid, and mixtures th ereof (See Page 5, Lines 3-7). Dicarboxylic acids used to coat the tablets have a melting point that is preferably from 40° C to 200° C (See Page 5, Lines 8-10). A method of coating is disclosed where molten dicarboxylic acid is applied to the compressed detergent tablet (See Page 2, Lines 16-28; and Page 5, Lines 11-24). The coated detergent tablets may further comprise additional components, including chelating agents (See Page 17, Line 26). In one example, adipic acid is prepared as a coating composition after being heated to a temperature of 170°C (See Page 19, Lines 16-19).

The Van Dijk document does not teach the addition of water to the molten dicarboxylic acid during the coating process, nor does it teach further process steps directly pertaining to the addition of water in the coating process.

The Sanders patent teaches a coating process comprising the preparation of a hot-melt coating composition comprising a combination of one or more solid aliphatic dioic acids (See Abstract; and Column 5, Lines 8-20). Dioic acids that are preferred in the coating process include those with about 5 to about 10 carbon atoms; specific acids include glutaric acid, adipic acid, pimelic acid, suberic acid, azelaic acid, and sebacic acid. The melting point of adipic acid is disclosed as being approximately 151°C (See Column 6, Lines 12-33). It is disclosed that the use of large of solvents are to be avoided in the coating process, minor amounts of such solvents

can be tolerated and may even be beneficial. A small amount of water, up to about 5% by weight of the coating composition, will act as a plasticizer and rheology-modifier without requiring a solvent drying step (See Column 5, Lines 21-34; and Column 7, Lines 40-63).

It would be obvious to one of ordinary skill in the art to combine the teachings of Van Dijk and Sanders into the objects of the instant application. The disclosed coating processes of Van Dijk and Sanders are both directed to the application of molten dicarboxylic acids as a coating. Both Van Dijk and Sanders also list some of the same specific dicarboxylic acids as preferred coating materials in their respective disclosures. It is the position of the examiner that one of ordinary skill in the art would be motivated to add relatively small amounts of water into the coating process of Van Dijk in order to incorporate the benefits of such a step as taught by Sanders, with a reasonable expectation of success. It is also the position of the examiner that it is within the purview of one of ordinary skill in the art to envision the claim limitations directed to process temperature, timing of the addition of water, and feed rates of water. The examiner therefore shifts the burden onto the applicant to show the criticality of such limitations. Furthermore, claim limitations concerning process temperatures of the dicarboxylic acid coating are considered by the examiner to be rendered obvious in view of the process temperature of adipic acid of 170°C in the example of Van Dijk, which is clearly more than 5°C above the approximate melting point of 151°C of adipic acid as disclosed in Sanders. Thus, the claimed invention as a whole is *prima facie* obvious.

Response to Arguments

Applicant's arguments filed 01 April 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a method of preventing discoloration of a dicarboxylic acid coating) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both prior art references deal with the application of a dicarboxylic acid coating using several common suitable materials.

In the view of the examiner, that the Sanders patent deals with dicarboxylic acid coating compositions that are applied to pressure-sensitive carbonless record sheets rather than to tablets does not disqualify it as a relevant piece of prior art. The motivation to combine the references comes from the disclosure in Sanders that water may be added to such coating compositions to improve its properties, as stated above. It is the position of the examiner that the applicant has applied a narrow view of the prior art in its response to the examiner's first rejection, and that one of ordinary skill in the art, giving both the prior art and the claims in their present form their broadest reasonable interpretation, would find the claimed invention obvious in view of the prior art. See MPEP § 2111 and 2123.

Whether the step of adding water to a dicarboxylic acid coating composition occurs before, during, or after the step of melting the dicarboxylic acid is not considered by the examiner to be a feature that distinguishes the instantly claimed invention above the prior art. Changes in the sequence of adding ingredients of a composition is but one example directed to various common practices that the court has held normally require only ordinary skill in the art, and hence are considered to be within the realm of routine experimentation. *Ex parte Rubin*, 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclosing a process of making a laminated sheet

wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render *prima facie* obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps). See also *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (Selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results). This one particular component of the instantly claimed invention cannot considered to be patentable without a demonstration by the applicant showing the criticality of this limitation. See MPEP § 2144.04.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon J. Oh whose telephone number is (703) 305-3265. The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

Simon J. Oh
Examiner
Art Unit 1615

sjo
June 20, 2003

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
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